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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,799	07/28/2003	Markus Hamulski	HAMULSKI AL-5	4531
25889 7590 10/10/2008 COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576				
EXAMINER				
DESAL, ANISH P				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/628,799

Applicant(s)

HAMULSKI ET AL.

Examiner

ANISH DESAI

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) 14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's arguments in response to the Office action mailed on 02/15/08 have been fully considered.
2. Claims 1-4 and 8-15 are pending. Claims 5-7 are cancelled and claim 14 and 15 are withdrawn. Support for the newly amended claims is found in the specification. Additionally, it is noted that Applicant has incorporated claim 5 limitation of the adhesive strength in claim 1.
3. All of the previously made art rejections are maintained. Additionally, the Examiner is providing English translation of Hisao (JP 08-324676).

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, and 8-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hisao (English translation of JP 08-324676), substantially as set forth in 02/15/08 Office Action.

5. Regarding the preamble of claim 1 "Self-adhesive surface protection film for covering painted sheet metal...made of aluminum or stainless steel" is interpreted to be an intended use of the self-adhesive surface protection film. Therefore, if a prior art discloses an adhesive tape having a carrier layer and an adhesive layer as claimed by claim 1, then such an adhesive tape is considered to be capable of covering painted sheet metal and high-gloss sheet metal made of aluminum or stainless steel.

6. Regarding claims 1-3, 8, and 10 Hisao teaches a cover tape (self-adhesive surface protection film) for packaging electronic parts. The cover tape of Hisao includes a layered laminate including a biaxially oriented film 2 (equated to Applicant's carrier layer) and a sealant layer 4 (equated to Applicant's adhesive layer); wherein the sealant layer of Hisao is made of a mixture of polyethylene or polypropylene with a hydrogenated styrene-isoprene-styrene block copolymer (0003). The biaxially oriented film (carrier layer) of Hisao is formed of polyester, polypropylene or nylon (0004). Further, Hisao is silent as to teaching that the styrene block copolymer of his invention is plasticized with oils or resins. Additionally, the thickness of the biaxially oriented film of Hisao is from 5 to 30 microns (0005) and the thickness of the sealant layer of Hisao is from 5-30 microns (0005). As to the claim requirement of self-adhesive film "for covering painted sheet metal...or stainless steel", it is noted that the cover tape of Hisao comprise a biaxially oriented film (i.e. carrier layer) and an adhesive layer having the same composition as that of claimed by Applicant in claim 1. It is respectfully submitted that the cover tape of Hisao is structurally and compositionally similar to Applicant's self-adhesive surface protection film. Thus, the cover tape of Hisao is capable of meeting

the intended use requirement of covering painted sheet metal and high-gloss sheet metal made of aluminum or stainless steel as required by claim 1.

7. As to the claim requirement of layered laminate produced by coextrusion, this limitation is related to product by process limitation. The product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir.1985).

8. Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). In the instantly claimed subject matter, the self adhesive film of Applicant includes a layered laminate comprising a carrier layer and an adhesive layer; wherein the adhesive layer of Applicant consists of a composition as set forth in claim 1. The self adhesive film of Hisao is previously disclosed and it includes a layered laminate comprising a carrier layer and an adhesive layer having the same composition as that of Applicant's claim 1.

Therefore, the products of the prior art and that of Applicant are structurally and compositionally equivalent.

9. Hisao is silent as to teaching the claimed property of the adhesive strength; however it is reasonable to presume that said property is present in the adhesive tape of Hisao. The support for said presumption is based on the fact that the products of Hisao and that of Applicant comprise a carrier layer and an adhesive layer of identical composition as set forth in claim 1. Therefore, the products of Hisao and that of Applicant are structurally and compositionally equivalent. Thus, the presently claimed property of the adhesive strength would be present. The burden is shifted to Applicant to prove it otherwise (*In re Fitzgerald*, 205 USPQ 594).

10. Regarding claim 9, Hisao teaches an anchor coat layer that is between the biaxially oriented film (carrier layer) and the sealant layer (adhesive layer) (0003 and 0007). Alternatively, it is known in the adhesive tape art to provide a layer of bonding agent (primer layer) between backing (carrier) and an adhesive to improve delamination strength between the adhesive and carrier. Therefore, it would have been obvious to one of ordinary skill in the art to include a primer layer, tie coat or anchor layer in the composite of Hisao motivated by the desire to improve the bonding between the backing and the adhesive.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisao (English translation of JP 08-324676), substantially as set forth in 02/15/08 Office Action.

12. As to the claim requirement of di-block content of less than 1% by weight, Hisao discloses claimed invention except for the di-block content, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the optimum range of the di-block content in the invention of Hisao, since doing so would involve routine skill in the art.

13. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisao (English translation of JP 08-324676) in view of Cray et al. (US 2002/0061998A1), substantially as set forth in 02/15/08 Office Action.

14. Hisao is silent as to teaching a release layer as claimed. However, Cray discloses silicone release coating compositions that are useful in applications where relatively non-adhesive surfaces are required, for example backing papers for PSA labels (abstract and 0003). Further, the release coating compositions of Cray includes additives such as chalk (0063). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the release coating of Cray in the invention of Hisao, motivated by the desire to easily unwind the adhesive film from a roll.

15. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hisao (Machine translation of JP 08-324676) in view of Cray et al. (US 2002/0061998A1) as applied to claim 11 above, and further in view of Mazurek et al. (US 5,650,215), substantially as set forth in 02/15/08 Office Action.

16. Hisao is silent with respect to teaching the release layer having a micro-embossed surface produced by an embossing roller. However, Mazurek discloses pressure-sensitive adhesive tape having microstructured adhesive (abstract and drawings). Further, Mazurek discloses a microstructured release liner (column 5 lines 5-6), which reads on micro-embossed surface as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to micro-embossed the surface of the release layer, because an adhesive tape with such a release layer would be easier to unwind from a roll without release layer sticking to the surface of the adhesive layer. As to the requirement of micro-embossed surface produced by an embossing roller, the same reasoning as set forth previously with regards to the product by process claim is incorporated here by reference, because the recitation "produced by an embossing roller" is a process limitation.

Response to Arguments

17. Applicant's arguments filed 08/18/08 have been fully considered but they are not persuasive.

18. With respect to the 35 USC Section 102(b) or 103(a) rejections based on Hisao (JP 08-324676) Applicant argues that the primary reference of Hisao fails to teach or suggest and in fact does not relate to a self-adhesive surface protection film, but rather

to a covering for packaging of electronic components (page 8 of 08/18/08 amendment).

The Examiner respectfully disagrees for the following reasons:

19. It is respectfully submitted that the recitation "Self-adhesive surface protection film...for covering painted sheet metal...stainless steel" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). It is noted that the cover tape of Hisao includes a biaxially oriented film (equated to Applicant's carrier layer) and a sealant layer (adhesive layer); wherein the sealant layer consists of a mixture of styrene block copolymer which is not plasticized with oils or resins and polyethylene or polypropylene (see 0003 of Hisao). Applicant's claimed adhesive film includes a carrier layer and an adhesive layer consisting of polyolefin wherein the polyolefin is selected from either polyethylene or polypropylene, and a styrene block copolymer that is not plasticized with oils or resins. Thus, the cover tape of Hisao is structurally and compositionally equivalent to Applicant's adhesive tape. Additionally, no factual evidence on the record is presented by Applicant that would indicate that the cover tape of Hisao is not functionally capable of meeting the preamble recitation of "Self-adhesive surface protection film...stainless steel".

20. Applicant further argues that the Hisao does not describe that the sealing layer demonstrates self-adhesive properties (page 9 of 08/18/08 amendment). The Examiner respectfully disagrees for the reasons as set forth above in Section 19 which are incorporated here by reference.

21. Applicant argues that "In particular, Hisao fails to provide a person skilled in the art with any...to adjust polymer compositions of the film in such a manner...and 3.5 N/cm. Hisao also does not give any indication that such a self-adhesive film can be used and pulled off sensitive surfaces, without leaving any residue." (page 10 of Applicant's 08/18/08 amendment). The Examiner respectfully disagrees, because said arguments are not commensurate in scope with the claimed invention. It is respectfully submitted that Applicant's assertion of adjustment of polymer composition is interpreted as concentration (e.g. amount of each polymer that is contained in Applicant's adhesive). This is not found persuasive because there is nothing in the claims that requires adjusting of polymer compositions of the film and the pulling off the film from a sensitive surface without leaving any adhesive residue. Accordingly, Applicant's arguments are not found persuasive.

22. With respect to Applicant's arguments regarding the references of Cray et al. (US 2002/0061998A1) and Mazurek et al. (US 5,650,215), the Examiner respectfully submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The reference of Cray is relied upon to render claims 11

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and 12 obvious and the reference of Mazurek is relied upon to render claim 13 obvious. Accordingly, Applicant's arguments are not found persuasive in determination of patentability.

Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

24. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./

Examiner, Art Unit 1794

/Hai Vo/

Primary Examiner, Art Unit 1794